



Image RCE 11626
\$

MS RCE
PATENT
2224-0194P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Hiroyuki MIURA et al. Conf.: 6379
Appl. No.: 09/980,588 Group: 1626
Filed: December 4, 2001 Examiner: R. Anderson
For: PROCESS FOR SEPARATING IMIDE COMPOUNDS

REQUEST FOR CONTINUED EXAMINATION
UNDER 37 C.F.R. § 1.114

MS RCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

January 8, 2004

01/09/2004 JADD01 00000065 09980588

01 FC:1251
02 FC:1801

110.00 OP
770.00 OP

Sir:

This is a "Request for Continued Examination" under 37 C.F.R. § 1.114, the provisions of which do not apply to:

(1) A provisional application; (2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995; (3) An international application filed under 35 U.S.C. §363 before June 8, 1995; (4) An application for a design patent; or (5) A patent under reexamination.

Submission of an RCE is limited to an application in which prosecution is closed; e.g. final rejection, Ex Parte Quayle; or notice of allowability

☒ This Request for Continued Examination is being filed prior to the earliest of:

(1) Payment of the issue fee, unless a petition under § 1.313 is granted; (2) Abandonment of the application; or (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. § 141, or the commencement of civil action under 35 U.S.C. §§ 145 or 146, unless the appeal or civil action is terminated.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

☐ The enclosed document is being transmitted via facsimile.

☒ **Submission Required under 37 C.F.R. § 1.114:**

- ☐ Do **NOT** enter the After Final Amendment(s) previously filed on _____ under 37 C.F.R. § 1.116.

Enter as part of the present submission:

- ☒ The After Final Amendment(s) previously filed on December 8, 2003, under 37 C.F.R. § 1.116 but unentered, in the present application.
- ☐ Arguments in the Appeal Brief or Reply Brief previously filed on _____.
- ☐ A Reply Under Rule 1.111, attached hereto. Claim fee(s) are calculated as set forth below:

	TOTAL NUMBER OF CLAIMS PREVIOUSLY PAID FOR	TOTAL NUMBER OF CLAIMS BEING FILED HEREWITH	<u>NUMBER EXTRA</u>	Large Entity		Small Entity	
				Rate	Fee	Rate	Fee
Total Claims	20	4 =	0	X 18	\$	X 9	\$
Independent Claims	3	1 =	0	X 86	\$	X 43	\$
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM				290	\$	145	\$
TOTAL CLAIM FEE(S)						\$0.00	

- ☐ An Information Disclosure Statement (IDS) and PTO-1449 form(s) is/are attached hereto for the Examiner's consideration.

- ☒ Other: Request for Reconsideration

☐ **Miscellaneous**

- ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a period of () months. (Period of suspension shall not exceed 3 months.)

☒ **Fees**

The required fee under 37 C.F.R. § 1.17(e) as required by 37 C.F.R. § 1.114 when the RCE is filed, is enclosed herewith:

☐ \$385.00 - small entity

☒ \$770.00 - large entity

☒ The applicant(s) hereby petition(s) for an extension of one (1) month(s) pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). The fee has been calculated as shown below:

☒ NO extensions of time have been previously obtained in the prior application. Thus, a fee of \$110.00 is required for the full period of the above-requested extension of time.

☐ An extension of () month(s) was previously requested and paid for on in the instant application. Thus, a fee of \$0.00 is required to obtain an additional () month(s) extension.

☐ The fee of \$130.00 under 37 C.F.R. § 1.17(i) for suspension of action is enclosed.

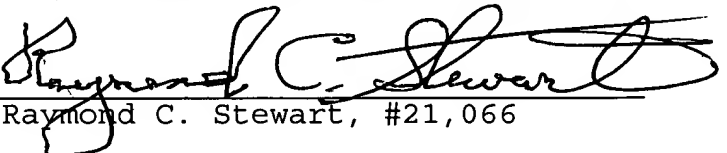
☒ Enclosed is(are) check(s) in the total amount of \$880.00 for the applicable filing fee, additional claims fee, suspension fee, and/or extension fees.

☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Raymond C. Stewart, #21,066

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000


RCS/RG/csm
2224-0194P

Attachment(s)

(Rev. 09/30/03)



PATENT
2224-0194P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Hiroyuki MIURA et al. Conf.: 6379
Appl. No.: 09/980,588 Group: 1626
Filed: December 4, 2001 Examiner: ANDERSON
For: PROCESS FOR SEPARATING IMIDE COMPOUNDS

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner had previously alleged that the phrase “with the proviso that said substrate is not an isoprenoid having an allylic group” – which phrase distinguishes the present claims over the Foricher patent – has no basis in the specification, and accordingly constitutes new matter. By amendment, the proviso in question has been adjusted to employ language taken directly from claim 1 of the Foricher patent. In an Advisory Action mailed December 24, 2003, the Examiner argued that Applicants cannot specifically exclude something not specifically described in the specification.

In *In re Johnson and Farnham*, 194 USPQ 187, the court noted that “Inventions are constantly made which turn out not to be patentable, and


applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable." 194 USPQ at 195. In *Johnson*, the court held that


The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a lost interference count.

194 USPQ at 196. Similarly, here, all that has happened is that Applicants have narrowed their claims to avoid having them read on a prior art patent. The Examiner is respectfully requested to indicate why the law expounded in *Johnson* does not control the present situation.

The Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at (703) 205-8008 in order to arrange an interview in which any issues remaining in the present application can be resolved.

Respectfully submitted,
BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Raymond C. Stewart # 21,066

RCS/RG 
2224-0194P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000